

## REMARKS

### Confirmation of Election

Applicant confirms the election of the species associated with Figures 1–5. Claims considered as reading thereon include new independent Claim 23 and Claims 3, 4, 5, 7, 8, 20 and 21. Claims 20 and 23 are considered to be generic.

### Amendments to the Drawings

Corrected drawings are presented. Applicant considers that these drawings address all the objections noted by the Examiner. In this respect note that the numeral “58” has been added to Figures 4 and 5; the view numbers are now larger than the reference numbers; Figures 2A and 6A now omit the arrowed line; and the reference characters 152 (two occurrences in Figure 9) have been changed to “150”. Each sheet is appropriately labeled as being a “Replacement Sheet”.

### Amendments to the Specification

The omissions, misspellings and grammatical errors noted by the Examiner in both the Abstract and the Specification have been addressed. Applicant considers that the amendments as noted on pages 3–5 of this paper correct all the objections to the Specification and Abstract.

## Amendments to the Claims

Amendments to the claims include the cancellation of Claims 1, 2, 6, 10, and 14–17. A new Claim 23 has been added which combines features of cancelled claims 1, 2, 6 and 10. New Claim 23 is considered to be generic to the embodiments of both Figures 1–5 and 6–9.

Independent Claim 20 (also generic) has been amended to address the objections raised by the Examiner regarding a functional limitation.

Claims 3–5, 7–9, and 11–13 have been amended to correct dependency and to address the objections raised by the Examiner.

1. Claim 1 is cancelled so the rejection of Claim 1 under 35 U.S.C. 102 (b) as being anticipated by Dolan (US 6481780) is moot.

2. Claims 2, 14, 15 and 20 stand rejected under 35 U.S.C.103 (a) as being unpatentable over Dolan in view of Chapman (US 5146967). As Claims 2, 14 and are cancelled, Applicant's comments are directed to the rejection of Claim 20. In this respect the Examiner's position is that it would have been obvious to one skilled in the art to add the closable openings of Chapman to the canopy of Dolan.

The proposed modification appears to ignore the clear teaching of Dolan that the canopy has no openings but the structure is such that it does not obstruct access to the golf clubs and that the entire contraption is "easily removed or folded out of the way when a golfer has no need for the attachment" (Col 4, lines 51–52). Dolan even discloses an embodiment that has "additional members or curved members to

accommodate better access to the golf bag ..., or facilitate the movement of the attachment into and out of operative position” (column 5, lines 26–31, emphasis added). These are clear admonitions that Dolan’s canopy attachment remain whole and provide teachings that are contrary to any suggestion of providing the canopy itself with openings to access the golf clubs when the canopy attachment is in a deployed position. References that teach away cannot serve to create a *prima facie* case of obviousness [*In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1311, 1132 (Fed. Cir. 1994)].

3. Claims 3–5, 7, 8 and 21 all stand rejected under 35, U.S.C. 103(a) as being unpatentable over a combination of Dolan and other secondary references. As each of these claims is dependent on new independent Claim 23, Applicant’s comments are directed first to new Claim 23.

New Claim 23 is more definitive in the structure of the open rigid frame, the disposition of the canopy (having the closable openings) as being “movable relative to and along the frame” between deployed and stowed positions, the inclusion of a bias means urging the canopy to a stowed position, and a catch to hold the canopy in the deployed position. Dolan, neither alone nor in combination with any of the secondary references, renders new Claim 23 obvious, in part, because Dolan expressly teaches away from providing the canopy itself with access openings (see comments above). Dolan further lacks, among other

things, any suggestions of the particular structure of the rigid frame or the bias means and catch as claimed.

With respect to the rigid frame structure as set out in Claim 23, the Examiner in rejecting former Claim 6 (directed to frame details) noted that Dean (US 2, 520, 025) disclosed a framed cover comprising similar upright, horizontal and curved pieces and that it would be obvious to modify Dolan as taught by Dean as such an arrangement would “provide a more stable connection than the four point connection of Dolan” and “would avoid the unstable movement of the upper roof attachment points ... caused by persons repeatedly embarking and disembarking the golf cart seat.” The Examiner’s position does not meet the legal requirements for sustaining a rejection under 35 U.S.C. 103(a). The Federal Circuit Court Admonishes that

Conclusory statements such as those here provided do not fulfill the agency’s obligation. This court explained in *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697, “deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense.’” *In re Lee*, 61 USPQ2d 1430, 1435, 1436 (Fed. Cir. 2002).

Applicant points out that Dolan does suggest the use of a curved member in his frame (see Column 5, lines 26–31). However according to Dolan such use, among other things, would strengthen the attachment itself (rather than to stabilize it as suggested by the Examiner and allow “better access to the golf bag”; this latter benefit confirming Applicant’s position

that Dolan never intended and does not teach providing his canopy with openings to access the golf clubs when the canopy is deployed.

New Claim 23 includes reference to bias means urging the canopy to a stowed position and a catch to hold the canopy in the deployed position against the urging of the bias. Veilleux (US 3, 146, 824) is cited as disclosing both a bias means and a catch in the context of a deployed canopy. However, adding these elements to Dolan still falls short of the claimed invention, as the combination still would lack the closable openings for the reasons noted above.

Dependent Claims 3–5, 7 and 8 include all the limitations of Claim 23 and are therefore distinguishable from the references for the reasons set out above with respect to Claim 23. In addition Claims 3, 4 and 5, which stand rejected over a combination of Dolan and Veilleux can be distinguished in that there is no suggestion in the references themselves for the proposition that it is obvious to add a housing (Claim 3) to receive a rolled-up canopy or to bias the canopy toward a stowed position (Claim 4) or to provide a catch to hold the canopy in the deployed position (Claim 5). The unobviousness of the features as set out in each of these Claims 3–5 is particularly the case as Dolan simply says the canopy is removed entirely when not needed or is “rolled up and tied into position” (Column 5, lines 61–64).

Dependent Claim 7 is dismissed as merely reciting an unpatentable change of shape. However, Claim 7 is more in that it provides a “dog leg”

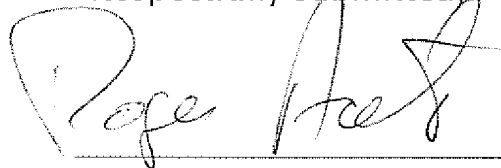
connection between two pieces and this dog leg connection provides the support for the ends of the housing (in which the canopy is stowed).

None of the references provide such a supporting arrangement.

Claim 8 is directed to a bead/channel arrangement for holding the canopy to the rigid frame. However, the teachings of Dolan that the canopy is removed from the frame when not in use precludes use of a bead/channel arrangement which ostensibly would prevent the separation of the canopy from the frame.

Accordingly, and in view of the above amendments and comments Applicant considers that the Claims a remaining in the case; namely claims 23, 3-5, 7, 8, 20 and 21 should be in condition for allowance. As Independent Claims 20 and 23 are generic, the withdrawn claims 9,11-13, 18, 19 and 22 also should be in condition for allowance, which action is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Roger Aceto", is written over a horizontal line.

Dated: June 5, 2006

---

Roger Aceto, Registration No. 24, 554  
HARTER, SECREST & EMERY LLP  
1600 Bausch & Lomb Place  
Rochester, New York 14604  
Telephone: 585-232-6500  
Fax: 585-232-2152